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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/836,589
Filing Date: April 17, 2001
Appellant(s): WIEDERIN ET AL.

MAILED

NOV 29 2007

GROUP 3600

Phouphanomketh Ditthavong
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 20, 2007 appealing from the Office action mailed November 30, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-------------|-----------------|--------|
| 20020115431 | Cox et al | 8-2002 |
| 6052439 | Gerszberg et al | 4-2000 |

6212506

Shah et al

4-2001

"BOC Expands Directory Options"; BOC Week v. 9, n2, Jan. 13, 1992.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5-9, 13-17, 21-25, 29-33 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 20020115431 A1, Cox et al. Filing date November 20, 1996 hereinafter referred to as Cox in view of US Patent 6052439 Gerszberg et al. Hereinafter referred to as Gerszberg and in further view of of Non-patent literature "BOC Expands Directory Options" BOC Week, Jan. 13, 1992, hereinafter referred to as BOC.

3. As to Claims 1, 9, 17 and 33 Cox teaches a system and method of tracking directory assistance listings displayed to a user and billing information based on directory listings. (Pg. 4 ¶ 00045-00047 and Claim 7.) Cox fails to teach transmitting information associated with one or more directory listings to a client access device over the packet switched network in response to a query initiated by a customer, wherein the customer selects one or more of the director listings based on the information.

Gerszberg teaches information being sent to a customers device according to the customer query destination number.(C. 8 l. 18-24). It would have been obvious to one skilled in the art at the time of invention to combine the teaches of Gerszberg with Cox so as to give the user more control of how and what information they are receiving from the service. Cox and Gerszberg fail to teach a plurality of listing and charging for the plurality of listings. BOC teaches a system and method for directory assistance that allows users to receive multiple listings and a process for charging the user for multiple listings. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Cox and Gerszberg with BOC so as to be able to receive the results that are provided and charge accordingly for the number of listings requested.

4. As to claims 5, 13, 21, 29 and 37 Cox teaches an enhanced directory assistance method and Gerszber teaches the directory service with user controlled query and specific type of information available(C. 7 l. 40-45) It would have been obvious at the time of invention to combine the teachings of Gerszberg with Cox as they are both systems and methods of directory assistance and Gerszberg gives additional "enhanced" information for the user to access.

5. As to claims 6, 14, 22, 30 and 38 Cox teaches a system and method of directory assistance and billing. Cox fails to teach a system and method that utilizes the internet network. Gerszberg teaches establishing protocol between networks (C. 4 l. 49-52). It would have been obvious to combine the teaches of Cox and Gerszberg at the time of invention to make the enhanced directories more accessible to the public.

6. As to claims 7, 15, 23, 32 and 39 Cox teaches a system and method determining a billing including flat rate charges for each directory assistance. (Pg. 1 ¶ 0006 middle of paragraph)

7. As to claims 8, 16, 24, 32 and 40 Cox teaches a system and method utilizing Directory Assistance Database Source available from US West, which is a Regional Bell Operating Company formed by the break up of AT & T in 1983. (Pg. 2 ¶ 0017.)

8. As to Claim 25 Cox teaches a system for tracking directory assistance listings and preparing and storing billing information into a database. (Pg. 4-5 Claim 7.) Gerszberg teaches information being sent to a customers device according to the customer query destination number.(C. 8 l. 18-24). It would have been obvious to one skilled in the art at the time of invention to combine the teaches of Gerszberg with Cox so as to give the user more control of how and what information they are receiving from the service. Cox and Gerszberg fail to teach a plurality of listing and charging for the plurality of listings. BOC teaches a system and method for directory assistance that allows users to receive multiple listings and a process for charging the user for multiple listings. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Cox and Gerszberg with BOC so as to be able to receive the results that are provided and charge accordingly for the number of listings requested.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3629

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 2-4, 10-12, 18-20, 26-28 and 34-36 are rejected under 35 U.S.C. 103(a)

as being unpatentable over US Patent Publication 20020115431 A1, Cox et al in view

of US Patent 6456709 Gerszberg et al. as applied to claims 1, 7-9, 15-17, 23-25, 31-

33 and 39-40 above, in further view of US Patent 6,212,506 B1 Shah et al; April 3,

2001; Filing date September 16, 1997.

12. As to Claims 2, 10, 18, 26, 34 Cox and Gerszberg teaches a system and method

of directory assistance tracking and billing and the information including directory

information. However, Cox and Gerszberg fails to teach the method of receiving the

request and transmitting billing information. Shah teaches a system and method of a

customer database used to determine rates for calls and routing information. (C. 4 L.

23-25 and 31-33 **C. 3. I. 50-55**). It would have been obvious to combine the teaches of

Cox and Gerszberg with Shah at the time of invention as being able to determine call

rates before placing the call saves customers from accumulating additional charges on their bills.

13. As to claims 3-4, 11-12, 19-20, 27-28 and 35-36 Cox teaches a system and method of directory assistance tracking and billing. However, Cox fails to teach the method of delivery. Shah teaches a system and method where information can be delivered via fax or computer. (C. 3 L. 13-15.) It would have been obvious to combine the teaches of Cox with Shah at the time of invention as different individuals different preferences as to type of billing delivery.

(10) Response to Argument

Appellant sets forth arguments that the examiner has failed so establish a case of prima facie for obviousness on the basis that the examiner is required to provide "factual" basis to support a conclusion of obviousness.

Appellants makes arguments against the rejection of claim 1 as failing to teach transmitting a plurality of directory listing in response to the selection of more than one of the directory listings which were supplied as a consequence of customer initiated query.

Applicant argues Cox et al individually as not teaching transmitting more than one directory listing. However, Cox is not relied on for teaching transmitting the multiple listings. The non-patent literature reference BOC is relied on for teaching sending the multiple listing.

Appellant further argues that the combination of Cox and Gerzberg is improper because Cox teaches away from combination. Appellant states Cox teaches the cell

carrier being responsibility for charging, such that the combination with Gerszberg would undermine the system of Cox. The examiner notes in order for a reference to be considered to teach away the combination must result in the reference (Cox et al) not working, Cox et al would have to explicitly state that the Cellular carrier can be the only embodiment for which will work. However, the examiner notes on Pg. 4 ¶ 47 in which Cox et al discloses that the principles are describing the "preferred" embodiment that can easily be modified without departing from such principles. In light of such disclosure the examiner maintains the combinations do not teach away from the claimed invention. The examiner additionally notes that Gerzberg was not being combined with Cox et al for the limitation of charging for services, Gerzberg is relied on for sending directory listing to the user in response to a query.

The appellant argues that the examiner fails to establish "realistic" motivation for the combination of the three references as examiner has failed to present factual findings and explain why, however, additionally argues that examiner must "offer some articulated reasoning". Appellant argues that examiners rational that one would be motivated to combine Cox, Gerszberg with BOC so one would be able to receive the results that are provided and be charged accordingly for the number of listings acquired. The examiner ascerts that in any business or service industry when one provides multiple products (ie listings) it is well known in the business/service world to charge for the amount/number of services and/or products being received. That in and of itself provides a reasonable expectation of success.

The appellant further argues that the examiners reasoning for combining Gerszberg with Cox et al has not foundation in the disclosure. As appellant has pointed out (Pg 10¶5) motivation is not explicitly required but some articulated reasoning. The examiner notes Sakraida, 425 US At 282,189 USPQ at 453; in which it is supported that if each element of the references relied on as prior art when combined perform the same function that they would yield predictable results. Thus, one skilled in the art would recognize that the combination would improve similar methods.

On pg. 11 the appellant again returns to the argument that proposed combination undermines the objective of Cox et al. The appellant argues that a “proposed” modification of making it the responsibility of the directory assistance for charging. The examiner first addresses the fact that the claims do not claim nor limit who is doing the charging for the services. The Appellant state that the arguments are not about the “claims per se”. The examiner respectfully disagrees because again the limitations for which the appellant is arguing the improper combination are not the limitations for which the combination of Gerszberg with Cox et al is being relied on, ie billing for the listing. The examiner secondly notes that Gerszberg is not being relied the directory listing. BOC is the combined reference being relied of for teaching the billing of multiple listings in which Southwest Bell is doing the charge, of which Southwest Bell is both the carrier and the Directory Assistance provider. Additionally as state supra Cox et al discloses that the principles are describing the “preferred” embodiment that can easily be modified without departing from such principles. In light of such disclosure the examiner maintains the combinations do not teach away from the claimed invention. The

examiner additionally notes that Gerzberg was not being combined with Cox et al for the limitation of charging for services, Gerzberg is relied on for sending directory listing to the user in response to a query. The examine stresses that the combination of Cox, Gerszberg and BOC is not being used to teach "who" is doing the charging, as appellant does not limit who can do the charging, the combination is merely being relied on for teach the billing for multiple listings.

The appellant additionally argues that the combination fails to "yield" the claimed invention. The appellant argues that Gerszberg fails to teach "receiving multiple" listings after a user has made a selection. The examiner notes Gerszberg is not being relied on for receiving multiple listings in response to the user selection, but rather the multiple listing being sent in response to user QUERY. BOC is the reference being relied on for receiving multiple listing when SELECTED the user. BOC "allows" customers to get more than the usual two directory listings per call from the directory assistance. Two is multiple listing on top of allowing more than the initial two. The examiner maintains that it is implied that if a user is receiving two listings it is in response to some type of selection by the user. The directory assistance would not send unwanted to listings to the user. Furthermore, the examiner notes the appellant fails to disclose how appellant's "partial" information distinguishes itself from the information that is transmitted by Gerszberg.

The examiner again maintains appellants arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

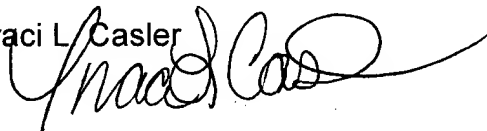
Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As to appellants arguments against the rejection of dependent claims based on the additionally combined reference Shah, in that the references fail to teach sending "partial directory" information. The examiner notes appellant states Shah fails to teach this limitation. However, the examiner notes that Shah is being relied on for the limitation of transmitting billing information to the client, not sending partial directory information to the user. Appellant argues that Gerszberg "merely" provides the option with "more" information does not mean that the already supplied information is only partial information. The examiner notes that the applicant fails to limit the in the claim language what constitutes "partial" information vs. complete information. Therefore, if the user is able to obtain more information regarding the directory listing than obviously all the information available through the directory listing was therefore only a "part" of the directory information was shared.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Traci L. Casler



Conferees:


John G Weiss



Jamisue Plucinski



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ART UNIT 3629
FEB 10 2010